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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,284	08/24/2001	Jeffrey A. Tilton	24938A	2609

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EXAMINER

WACHTEL, ALEXIS A

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/939,284	Applicant(s) TILTON ET AL.	
	Examiner Alexis Wachtel	Art Unit 1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

1. The finality of the last Office action is withdrawn. The instant Office Action address Applicant's arguments as set forth in the appeal brief filed on 3-2-2004.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Per claims 3,4,5,6 and 7, Applicant is claiming subject matter that is precluded by the use of "consisting essentially of language" in claim 1. Appropriate correction is recommended.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1,3-7 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6,008,149 to Copperwheat.

Copperwheat discloses a multi-layered molded nonwoven fibrous composite article. The composite is made of the same non-woven thermoformable polymeric chemical substance. Suitable polymeric material includes polyester (Col 2, lines 3-16). The composite can be used to manufacture auto headliners, trunk liners and passenger

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compartment components (Col 2, lines 3-16). One embodiment proposes a moldable composite structure wherein a sheet of polyester variable compression fabric is sandwiched between two sheets of formable polyester in the form of a needlepunch felt, thereby forming a composite article (Col 4, lines 9-15). The formable fabric has a basis weight of 4 to 18 oz/yd² corresponding to 13.82 g/ft² to 62.21 g/ft² (Col 4, lines 1-7). Examiner notes that the variable compression fabric has insulating properties at least to some degree. Examiner also notes that absent any disclosure of color altering fillers or the like, the layers of the moldable composite structure are assumed to have the same color.

6. Claims 1,3,4,5,6,7,8-13 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,501,898 to Fottinger et al. 1,3,4,5,6,7

Fottinger et al discloses a car insulation composite (Col 1, lines 24). Such a composite can be a three layer composite wherein the outer two layers are made of polybutylene terephthalate fibers (Col 2, lines 35-40). The central layer is made of equal portions of polyethylene terephthalate fibers and bicomponent fibers made of polyethylene terephthalate and a copolyester with a lower melting point (Col 2, lines 45-52). Given that the three layers of the resulting composite are polyesters, it is reasonable to assume that they have similar colors. The central layer has a weight of 500g/m² (47g/ft²) (Col 4, lines 28-29). Additionally, the three layer composite manufactured in accordance with the teachings of Fottinger can also be configured such that the central layer is a thermally pre-compacted needled nonwoven that is consolidated with two outer layers (Col 4, lines 63). The Examiner notes that the

thermal pre-compaction step is necessarily described in Example 1 (Col 3, lines 60-67, Col 4, lines 1-18). Such a pre-compaction step will afford multidensity characteristics to the central layer and will afford a facing surface to said central layer that has a higher density than the interior of said central layer.

Response to Arguments

7. Applicant argues that claim 1 reads on a trim panel insulator for a vehicle consisting essentially of a single, multidensity nonlaminar acoustical and thermal insulating layer... (pp.6, Appeal Brief, 5th paragraph). Additionally, Applicant argues that claim 1 as drafted covers embodiments including a skin 14 (Appeal Brief, pp.9). The Examiner agrees.

The Applicant asserts that the basic and novel characteristics of the trim panel insulator 10 constructed in accordance with the teachings of the present invention provide a unique combination of mechanical strength and rigidity as well as thermal and acoustical properties which are consistently and reliably maintained over a long service life even when installed in the proximity of a high temperature heat source such as a catalytic converter (Applicant's Specification, pp.7, lines 16-25). Accordingly, the Examiner believes that Applicant's usage of "consisting essentially" of language does not allow for the inclusion of a first and second facing layer as claimed in claims 3 and 4, since the first and second facing layers would serve to "enhance" and in particular, materially affect the basic and novel characteristics of the trim panel insulator as claimed in claim 1 thus constituting a departure from the intended scope of claim 1. The transitional phrase "consisting essentially of" limits the scope of a claim to the specified

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materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original) (Prior art hydraulic fluid required a dispersant which appellants argued was excluded from claims limited to a functional fluid "consisting essentially of" certain components. In finding the claims did not exclude the prior art dispersant, the court noted that appellants' specification indicated the claimed composition can contain any well-known additive such as a dispersant, and there was no evidence that the presence of a dispersant would materially affect the basic and novel characteristic of the claimed invention. The prior art composition had the same basic and novel characteristic (increased oxidation resistance) as well as additional enhanced detergent and dispersant characteristics.). "A consisting essentially of claim occupies a middle ground between closed claims that are written in a consisting of format and fully open claims that are drafted in a comprising format." PPG Industries v. Guardian Industries, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998). See also Atlas Powder v. E.I. duPont de Nemours & Co., 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); In re Janakirama-Rao, 317 F.2d 951, 137 USPQ 893 (CCPA 1963); Water Technologies Corp. vs. Calco, Ltd., 850 F.2d 660, 7 USPQ2d 1097 (Fed. Cir. 1988). For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355 ("PPG could have defined the scope of the phrase consisting essentially of" for

purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention.”). See also *In re Janakirama-Rao*, 317 F.2d 951, 954, 137 USPQ 893, 895-96 (CCPA 1963). If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of “consisting essentially of,” applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant’s invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989).

With respects to the applicability of the Copperwheat reference as prior art, Applicant argues that Copperwheat explicitly teaches and describes using multiple laminated layers of material in order to provide different densities. This is incorrect. Copperwheat clearly makes use of at least one nonlaminated layer that has differing densities. The variable compression fabric (2) is explicitly described as being capable of assuming variable thickness and density (Col 2, lines 22-24).

With respects to the applicability of the Fottinger reference as prior art, Applicant argues that three layer laminate disclosed by Fottinger does not anticipate claims 8-13 since Fottinger fails to teach a single nonlaminated acoustical and thermal insulating layer with a nonlaminated skin of polymer fiber along at least one face thereof. As set forth above in section 6 of the instant office action, Fottinger clearly teaches a three layer laminate wherein the central layer of said laminate is a multidensity laminate having a face with higher density than the interior of said central layer.

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Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex Wachtel whose telephone number is 571-272-1455. The examiner can normally be reached on 10:30am to 6:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Glenn Caldarola, can be reached at (571)-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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